

EXPRESS MAIL LABEL NO. EV 021 611 714 US

PATENT APPLICATION
Docket No. 15268.1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Gast, et al.

Serial No.: 09/646,767

) Art Unit

) 3641

Filed: November 30, 2000

)

Conf No. 7760

)

For: PROPELLANTS FOR GAS GENERATOR

)

Examiner: Aileen Jeanette Baker

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Box RESPONSES

NO FEE

Assistant Commissioner for Patents

Washington, DC 20231

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Dear Sir:

In response to the Election/Restriction Requirement dated September 9, 2002, (paper No. 9), Applicant respectfully submits the following to be filed in the above-identified application.

The Examiner has requested an election of a single disclosed invention. The Examiner has identified the inventions as follows:

Group I as containing claim(s) 1-15, drawn to a propellant;

Group II as containing claim 16, drawn to the use of a propellant

In response to this Restriction Requirement, Applicants refer the Examiner M.P.E.P. § 1893.03(d), which describes the unity of invention guidelines that must be followed when determining whether claims possess or lack unity of invention. "Examiners are reminded that

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unity of invention (not restriction) practice is applicable in International applications (both chapter I and II) and in a national stage (filed under 35 U.S.C. § 371) applications. Restriction practice [only applies] to U.S. national applications filed under 35 U.S.C. § 111(a)." M.P.E.P. § 1893.03(d). Because the above-identified application is a national stage application filed under 35 U.S.C. § 371, and not a U.S. application filed under 35 U.S.C. § 111(a), the Examiner must follow the guidelines set forth in M.P.E.P. § 1893.03(d) instead of M.P.E.P. § 800 *et. seq.* It appears, however, that the PTO has followed the guidelines for ordinary U.S. applications instead of national stage applications under 35 U.S.C. § 371. On this basis, Applicants object to the Restriction Requirement set forth in the Office Action.

In addition, Applicants note that the unity of invention standard applicable to national stage applications filed under 35 U.S.C. § 371 are quite liberal compared to restriction practice:

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.

M.P.E.P. § 1893.03(d).

Applying this rule to the present case, it is abundantly clear that each of the claims in the above-identified application are drawn to a "single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding technical feature." *Id.* In particular, claim 16 as amended in the preliminary amendment in September 19, 2002, is no longer a method of use claim but a propellant claim such that it is now simply a dependent claim depending from independent claim 1. In view of this, it is hard to see how claim 16 lacks unity of invention relative to claim 1. In addition, even if claim 16 were still a method of use claim as originally filed, wherein claim 16 depended from any one of claims 1-

15, the very fact that original claim 16 incorporated all of the limitations (*i.e.*, technical features) of claims 1-15 indicates that original claim 16 shared “a single general inventive concept” with claims 1-15.

In view of the foregoing, Applicants believe that the Restriction Requirement is erroneous because (1) it was erroneously applied to original claim 16, which clearly shares the same technical features of claims 1-15 from which it originally depended and (2) because amended claim 16 is of the same type as claims 1-15 such that it now falls within Group I of claims in any event. Accordingly, Applicants are unable to elect from between claims 1-15, on the one hand, and claim 16, on the other, because they define the same general subject matter and are directed to the same technical features. Applicants can, however, make the requested Election of Species requirement set forth in the Office Action.

Applicant is required, in reply to this action, to elect a single species based on the composition of the propellant (*i.e.* Applicant must elect one of elements A, B, C, D, and E) to which the claims shall be restricted if no generic claim is finally held to be allowable. Accordingly, Applicants elect the following species without traverse:

- A (fuel): nitroguanidine
- B (oxidizer): strontium nitrate
- C (slag trap): highly dispersed titanium dioxide
- D (slag former): alkali metal carbonates
- E (binder): cellulose compounds

In view of the foregoing Elections of Species, each of claims 1-16 is appropriate for examination because none of the claims are drawn solely to nonelected species.